

REMARKS / ARGUMENTS

Claims 42-59 and 90-93 are pending in this application. By this Amendment, Applicant AMENDS the specification and claims 42, 53, 57, and 93.

Applicant appreciates the Examiner extending the courtesy of the personal interview on July 17, 2007. During the personal interview, amendments to the specification and claims were discussed to overcome the outstanding objections and rejections.

The drawings were objected to for allegedly failing to show the decorative pattern area and failing to show reference characters 2 and 2a in Figs. 4(a)-4(c). Applicant respectfully submits that the decorative pattern area 2a is shown throughout the drawings, for example, in Figs. 1(a), 3, 6(a), 6(b), 7(a), and 7(b). Applicant also respectfully submits that the inclusion of the reference characters 2 and 2a in Figs. 4(a)-4(c) is not necessary for a proper understanding of the invention. Nevertheless, Applicant has amended the specification to delete the specific references to characters 2 and 2a with respect to Figs. 4(a)-4(c). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objections to the drawings.

Claim 93 was objected to for allegedly containing a minor informality. Applicant has amended claim 93 to correct the minor informality noted by the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection to claim 93.

Claims 44 and 92 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner alleged that claims 44 and 92 recite that the resin material spreads, whereas the specification only appears to show that the decorative sheet 10 spreads. Applicant respectfully disagrees. The specification discloses that the base member 1 of the decorative sheet 10 spreads to follow the unevenness of the molded article (see, for example, page 17, lines 6-8 in the specification). Furthermore, the base member 1 is disclosed as being made of a resin material (see, for example, page 15, lines 5-11 in the specification). Thus, it is clear that the resin material in the base member 1 of the

decorative sheet 10 spreads to follow the unevenness of the molded article.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 44 and 92 under 35 U.S.C. § 112, first paragraph.

Claims 42-59 and 90-93 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite (although the Examiner listed claims 42-93, claims 60-89 have been previously canceled). The Examiner alleged that the term "overlap" is not commensurate with the specification and drawings, that a pattern area cannot be considered to be "continuous," that it is not clear how the spread suppressing member "corresponds" to the pattern area or how the spread suppressing member suppresses the spreading of the pattern area if the spread suppressing member is on the second side of the base member, that it is not clear how the material "spreads to follow" a surface, and that the meaning of "including one of a metal and a metal compound" is not clear.

Applicant respectfully submits that the term "overlap" sufficiently describes how the spread suppressing member 3 covers only a portion of the base member 1, as shown, for example, in Fig. 1(a) and disclosed on page 19, lines 4-9 of the specification. Nevertheless, Applicant has replaced "overlap" with "cover" in accordance with the Examiner's suggestion so as to advance prosecution. Applicant respectfully submits that this amendment does not change the scope of the claims.

Applicant also respectfully submits that a pattern may be continuous or discontinuous and that there is absolutely no requirement that a pattern must be discontinuous.

Applicant also respectfully submits that the specification adequately describes and shows how the spread suppressing member 3 "corresponds" to the pattern area 2a. See, for example, page 17, lines 7-8 and the paragraph bridging pages 25 and 26 of the specification, and Figs. 1(a), 1(b), 7(a), and 7(b) of the drawings. Additionally, the spread suppressing member 3 prevents stretching of the base member 1, and thus the decoration layer 2 which is provided on a surface of the base member 1, regardless of which side of the base member 1 the spread suppressing member 3 is attached to (see,

for example, page 17, lines 5-15 and the paragraph bridging pages 25 and 26 of the specification).

Applicant also respectfully submits that Figs. 4(a)-4(c) show how the decorative sheet 10 spreads, e.g., stretches, to follow a surface. Applicant acknowledges that claims 44 and 92 do not recite the decorative sheet in combination with the article.

Lastly, Applicant respectfully submits that the meaning of “including one of a metal and a metal compound” (emphasis added) clearly recites that the spread suppressing member is either 1) a metal, or 2) a metal compound.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 42-59 and 90-93 under 35 U.S.C. § 112, second paragraph.

Claim 42 was rejected under 35 U.S.C. § 102(e) as being anticipated by Kauppi et al. (U.S. 2002/0048667). Claims 42-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jaynes (U.S. 6,491,782). Claims 42-50, 56, 59, 90, and 91 were rejected under 35 U.S.C. § 102(b) as being anticipated by Eichelberger et al. (U.S. 4,404,237). Claims 51, 54, 55, 57, 58, 92, and 93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eichelberger et al. Claims 42-59 and 90-93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Auld et al. (U.S. 6,548,128). Claims 56, 57, and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Auld et al. in view of Watanabe et al. (U.S. 6,748,641).

Applicant respectfully traverses the rejections of claims 42-59 and 90-93.

Claim 42 has been amended to recite:

A decorative sheet comprising:
a deformable base member having first and second principal surfaces opposed to each other;
a continuous decoration layer provided directly on the first principal surface of the base member and having a pattern area representing a predetermined pattern, the decoration layer being defined by an ink layer that is visible from a direction perpendicular to a plane including the ink layer; and
a spread suppressing member provided at a location corresponding to the pattern area on the side of the first principal surface or on the side of the second principal surface of the base member, for suppressing the spreading of the pattern area; wherein

the spread suppressing member is arranged so as to cover only a portion of the base member and is made of a material that suppresses the spreading of the pattern area of the decoration layer.
(emphasis added)

The Examiner alleged that Kauppi et al. teaches a base member 504, a decoration layer 502 provided directly on a surface of the base member 504, and a spread suppressing member 501. Applicant respectfully disagrees.

First, the decoration layer 502 of Kauppi et al. is not provided “directly” on the base member 504 due to the intervening spread suppressing member 501. Second, the spread suppressing member 501 of Kauppi et al. does not cover “only a portion” of the base member 504, as alleged by the Examiner on page 7, lines 2-3 of the Office Action. It is noted that during the personal interview on July 17, 2007, the Examiner agreed at the outset of the interview that Kauppi et al. does not teach each and every feature recited in claim 42.

Thus, Kauppi et al. fails to teach or suggest the features of “a continuous decoration layer provided directly on the first principal surface of the base member and having a pattern area representing a predetermined pattern” and “the spread suppressing member is arranged so as to cover only a portion of the base member and is made of a material that suppresses the spreading of the pattern area of the decoration layer,” as recited in Applicant’s claim 42.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. § 102(e) as being anticipated by Kauppi et al.

The Examiner alleged that Jaynes teaches a base member 17, a decoration layer 13, and a spread suppressing member 12 as recited in claim 42. Applicant respectfully disagrees.

The spread suppressing member 12 of Jaynes does not cover “only a portion” of the base member 17. Jaynes teaches a laminate made from large sheets wherein individual laminates can be die cut to card size from the large laminate (see, for example, column 3, lines 26-31 and Fig. 1 of Jaynes). Since the individual laminates are die cut from the large laminate, each of the layers of the individual laminates must

be of the same size. During the personal interview on July 17, 2007, Applicant's representative pointed out that Jaynes does not teach that the spread suppressing member 12 covers "only a portion" of the base member 17.

Thus, Jaynes fails to teach or suggest the features of "the spread suppressing member is arranged so as to cover only a portion of the base member and is made of a material that suppresses the spreading of the pattern area of the decoration layer," as recited in Applicant's claim 42.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. § 102(b) as being anticipated by Jaynes.

Claim 57 has been amended to recite:

A molded article comprising:
a molded article body; and
**a sheet joined to a surface of the molded article body; wherein
the sheet includes a deformable base member and a
continuous decoration layer provided directly on a surface of the
base member on the side of the molded article body;
the decoration layer includes a pattern area representing a
predetermined pattern and is defined by an ink layer that is visible
from a direction perpendicular to a plane including the ink layer;
a portion of the sheet corresponding to the pattern area has a
thickness which is in a range of about 1.1 times to about 1.8 times a
thickness of remaining portions of the sheet; and**
a spread suppressing member provided at a location corresponding
to the pattern area on the side of the first principal surface or on the side
of the second principal surface of the base member, for suppressing the
spreading of the pattern area of the decoration layer; wherein
the spread suppressing member is arranged so as to cover only a
portion of the base member and is made of a material that suppresses the
spreading of the pattern area of the decoration layer. (emphasis added)

The Examiner alleged that Eichelberger et al. teaches a base member 100, a decoration layer 101, and a spread suppressing member 102 as recited in claims 42 and 57. Applicant respectfully disagrees.

With respect to claim 42, Eichelberger et al. does not teach or suggest that the decoration layer 101 is visible from a direction perpendicular to a plane including the ink

layer. Since the spread suppressing member 102 disclosed by Eichelberger et al. is made of metal, the spread suppressing member is not transparent or translucent to allow the decoration layer 101 to be visible through the spread suppressing member 102. And, although the base member 100 disclosed by Eichelberger et al. may be, for example, polyester or polystyrene, there is no teaching or suggestion in Eichelberger et al. that the base member should be transparent or translucent so that the decoration layer 101 is visible through the base member 100. Furthermore, because the invention of Eichelberger et al. is drawn to a printed circuit, there would be no proper motivation to make the base member 100 transparent or translucent.

Thus, Eichelberger et al. fails to teach or suggest the features of “a continuous decoration layer provided directly on the first principal surface of the base member and having a pattern area representing a predetermined pattern, the decoration layer being defined by an ink layer that is visible from a direction perpendicular to a plane including the ink layer,” as recited in Applicant’s claims 42 and 57.

With further respect to claim 57, Eichelberger et al. does not teach that the sheet is joined to a molded article body, as alleged by the Examiner. Furthermore, because the invention of Eichelberger et al. is drawn to a printed circuit, there would be no proper motivation to attach the sheet to a molded article body.

Thus, Eichelberger et al. additionally fails to teach or suggest the features of “a sheet joined to a surface of the molded article body” and “the sheet includes a deformable base member and a continuous decoration layer provided directly on a surface of the base member on the side of the molded article body,” as recited in Applicant’s claim 57. It is noted that during the personal interview on July 17, 2007, the Examiner agreed at the outset of the interview that Eichelberger et al. does not teach each and every feature recited in claims 42 and 57.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. § 102(b) as being anticipated by Eichelberger et al. and the rejection of claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Eichelberger et al.

The Examiner alleged that Auld et al. teach a base member 17, 20, or 19 (although the Examiner listed element 13, it is noted that the Examiner also indicated that element 13 corresponds to the spread suppressing member); a decoration layer 12 or 16; and a spread suppressing member 13, as recited in claims 42 and 57. The Examiner acknowledged that the spread suppressing member 13 of Auld et al. does not cover only a portion of the base member 17, 20, or 19. However, the Examiner alleged that “changing the width of the metal [of the spread suppressing member] to overlap only a portion of the base is an optimizable feature as changing size is not patentably significant. It would have been obvious to one of ordinary skill in the art to have modified Auld to position the suppressing metal as claimed in order to achieve a desired design effect. It has been held that the provision of adjustability, where needed, involves only routine skill in the art. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art” (citations omitted). Applicant respectfully disagrees.

The Examiner’s numerous allegations are mere hindsight as the Examiner provides no specific motivation why the width, or “adjustability,” of the spread suppressing member is an optimizable feature or a result effective variable.

The Examiner is reminded that “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” In re Antonie, 195 USPQ 6 (CCPA 1977) and MPEP §2144.05(II)(B). Thus, Applicant respectfully requests that the Examiner provide a reference which teaches that the size, or coverage, of a spread suppressing member was an art recognized result-effective variable at the time of Applicant’s invention.

Furthermore, the Examiner is reminded that the U.S. Patent Office Board of Patent Appeals and Interferences has concluded that a rejection on the basis of design choice is clearly improper. In re Garrett, Appeal No. 580-81 (BPAI 1986) (wherein in reversing an obviousness rejection, the Board criticized that the Examiner’s statement

that the proposed modification would have been an obvious matter of engineering design choice with the explanation that such an assertion is a conclusion, not a reason). Further, the U.S. Court of Appeals for the Federal Circuit has concluded that a proper rejection must provide reasoning why a specific feature is a matter of design choice, and therefore obvious. In re Chu, 36 USPQ 2d 1089 (Fed. Cir. 1995).

Therefore, the Examiner has failed to establish a prima facie case of obviousness of the claimed invention because all the claim features must be taught or suggested by the prior art. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) and MPEP § 706.02(j) and § 2143.03.

During the personal interview on July 17, 2007, the Examiner suggested, alternatively, that the ink layer 12 of Auld et al. could be considered to be the spread suppressing member that covers only a portion of the base member 19. The Examiner further suggested that if claims 42 and 57 were amended to recite that the spread suppressing member is made of a material different from the decoration layer, then claims 42 and 57 would be allowable over Auld et al. However, Applicant respectfully submits that the ink layer 12 of Auld et al. is not a material that could function as a spread suppressing member because ink does not have the necessary rigidity to prevent the spreading of the base member 19 of Auld et al. That is, if the plastic base member 19 of Auld et al. (which would inherently have a higher rigidity than ink) was to spread under a given force, then the ink layer 12 of Auld et al. could not function to suppress the spreading of the base member 19.

Thus, Auld et al. fails to teach or suggest the features of "the spread suppressing member is arranged so as to cover only a portion of the base member and is made of a material that suppresses the spreading of the pattern area of the decoration layer," as recited in Applicant's claims 42 and 57.

With further respect to claim 57, the Examiner alleged that, with respect to the thickness of the sheet 10 of Auld et al., "it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being [sic] held that such a discovery, such

as an optimum value of the respective result effective variable involves only routine skill in the art" (citation omitted). Applicant respectfully disagrees.

Again, the Examiner is reminded that "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." In re Antonie, 195 USPQ 6 (CCPA 1977) and MPEP §2144.05(II)(B). Thus, Applicant respectfully requests that the Examiner provide a reference which teaches that an increased thickness of the sheet corresponding to a pattern area was an art recognized result-effective variable at the time of Applicant's invention.

Thus, Auld et al. additionally fails to teach or suggest the feature of "a portion of the sheet corresponding to the pattern area has a thickness which is in a range of about 1.1 times to about 1.8 times a thickness of remaining portions of the sheet," as recited in Applicant's claim 57.

The Examiner relied upon Watanabe et al. to allegedly cure deficiencies of Auld et al. However, Watanabe et al. clearly fails to teach or suggest the feature of "a portion of the sheet corresponding to the pattern area has a thickness which is in a range of about 1.1 times to about 1.8 times a thickness of remaining portions of the sheet," as recited in Applicant's claim 57. Thus, Applicant respectfully submits that Watanabe et al. fails to cure the deficiencies of Auld et al. described above.

Accordingly, Applicant respectfully submits that Auld et al. and Watanabe et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicant's claim 57.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 42 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Auld et al. and the rejection of claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Auld et al. in view of Watanabe et al.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 42 and 57 are allowable. Claims 43-56, 58, 59, and 90-93 depend upon

claims 42 and 57, and are therefore allowable for at least the reasons that claims 42 and 57 are allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a ONE-month extension of time, extending to August 3, 2007, the period for response to the Office Action dated April 3, 2007.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Dated: August 3, 2007

/Stephen R. Funk #57,751/
Attorneys for Applicant

KEATING & BENNETT, LLP
8180 Greensboro Drive, Suite 850
Tyson's Corner, VA 22102
Telephone: (703) 637-1480
Facsimile: (703) 637-1499

Joseph R. Keating
Registration No. 37,368

Stephen R. Funk
Registration No. 57,751